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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/589,084	10/04/2006	Anja Eitrich	P30301	5886

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EXAMINER	
BROWE, DAVID	

ART UNIT	PAPER NUMBER
1616	

NOTIFICATION DATE	DELIVERY MODE
04/29/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/589,084	EITRICH ET AL.	
	Examiner	Art Unit	
	DAVID M. BROWE	1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 February 2010*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *34-56* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *34-56* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claims 34-56 are pending; claims 1-33 are cancelled.

Applicants timely submission of amendments and arguments on February 16, 2010 in response to the First Office Action in the Merits is hereby acknowledged.

Withdrawal of Prior Claim Rejections - 35 USC § 103

Applicants cancelled claim 32, which was addressed in the First Office Action, and have now added new claims 34-56. Therefore, the 35 USC § 103 rejection of claim 32 presented in the First Office Action is hereby withdrawn, and a new grounds of rejection for newly added claims 34-56 is presented herein below.

NEW GROUNDS OF REJECTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 34-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stroud *et al.* (U.S. Patent No. 6,231,837), in view of Fowler (U.S. Patent No. 6,391,290).

Applicant Claims

Applicants claim a method of providing human skin with a natural tanned color, wherein the method comprises applying to human skin, in an amount which is sufficient to provide a tanned color, a cosmetic or dermatological self-tanning composition which comprises dihydroxyacetone and more than 5% by weight, based on the total weight of the composition, of glycerin. The composition employed in said method is an oil-in-water emulsion, with an inner-phase droplet size larger than 500 nm or larger than 1,000 nm; and comprising x wt% glycerin, wherein $8<x\leq12$ wt%; and exhibits a dihydroxyacetone:glycerin weight ratio y, wherein $1:4.5\leq y\leq 2:3$. The composition also comprises at least one oil-in-water emulsifier that is a polyethoxylated ester of stearic acid or a polyethoxylated castor oil; or is selected from the group consisting of

polyethoxylated esters of fatty acids having a chain length of 10-30 carbon atoms and a degree of ethoxylation of 5-100 and esters of saturated unbranched fatty acids with monomethoxylated glucose or polyglycerols. The at least one oil-in-water emulsifier is selected from the group consisting of sodium cetearyl sulfate, glyceryl stearate, glyceryl isostearate, glyceryl diisostearate, glyceryl oleate, glyceryl palmitate, glyceryl myristate, glyceryl lanolate, and glyceryl laurate. The composition further comprises at least one co-emulsifier that is cetearyl alcohol, or one or more other fatty alcohols having a chain length of 10-40 carbon atoms; and less than 5 wt% of at least one UV filter substance.

Determination of the Scope and Content of the Prior Art (MPEP §2141.01)

Stroud *et al.* disclose a method of providing human skin with a natural tanned color, wherein the method comprises applying to human skin, in an amount which is sufficient to provide a tanned color, a cosmetic or dermatological self-tanning composition which comprises dihydroxyacetone and more than 5% by weight, based on the total weight of the composition, of glycerin (Col. 1, lns. 15-17, 21-28; Col. 2, lns. 62-65; Col. 7, lns. 25-28, 31-40; Col. 8, lns. 42-45, 66-67; Col. 9, lns. 1-5, 23-25; Col. 10, lns. 28-38, 47-51; Col. 11, lns. 25-26; Col. 12, lns. 30-33; Col. 15, lns. 30-31, 38, 42, 45-47; Col. 18, lns. 6-7, 9; Col. 21, lns. 24-50; Col. 22, lns. 12-24, 48-51, 54-56). The composition employed in said method is an oil-in-water emulsion comprising x wt% glycerin, wherein $8<x\leq12$ wt%; and can be formulated to exhibit a dihydroxyacetone:glycerin weight ratio y, wherein $1:4.5\leq y\leq 2:3$ (Col. 7, lns. 25-28, 31-40; Col. 10, lns. 28-38, 47-51; Col. 15, lns. 30-31, 38, 42, 45-47; Col. 18, lns. 6-7, 9). The composition also comprises at least one oil-in-water emulsifier that is a polyethoxylated

ester of stearic acid or a polyethoxylated castor oil; or is selected from the group consisting of polyethoxylated esters of fatty acids having a chain length of 10-30 carbon atoms and a degree of ethoxylation of 5-100 and esters of saturated unbranched fatty acids with monomethoxylated glucose or polyglycerols (Col. 21, lns. 24-50; Col. 22, lns. 12-24, 48-51). The at least one oil-in-water emulsifier is selected from the group consisting of sodium cetearyl sulfate, glyceryl stearate, glyceryl isostearate, glyceryl diisostearate, glyceryl oleate, glyceryl palmitate, glyceryl myristate, glyceryl lanolate, and glyceryl laurate (Col. 21, lns. 24-50; Col. 22, lns. 12-24, 48-51). The composition further comprises at least one co-emulsifier that is cetearyl alcohol, or one or more other fatty alcohols having a chain length of 10-40 carbon atoms; and at least one UV filter substance (Col. 21, lns. 24-50; Col. 22, lns. 12-24, 48-51; Col. 24, lns. 6-29).

Fowler discloses an oil-in-water emulsion for topical application to the skin, with an inner-phase droplet size larger than 500 nm or larger than 1,000 nm; and comprising a sunless tanning agent, glycerin, at least one oil-in-water emulsifier, and at least one UV filter substance (Col. 2, lns. 23-24, 39-43; Col. 3, lns. 45-56; Col. 4, lns. 15-17, 39-41, 56-58; Col. 5, lns. 4-6, 10-12, 59-67; Col. 6, lns. 1, 8-11; Col. 7, lns. 24-25, 54-67; Col. 8, lns. 1-11).

Ascertainment of the Difference Between the Scope of the Prior Art and the Claims (MPEP §2141.012)

Stroud *et al.* do not explicitly disclose that the method employs an oil-in-water emulsion composition with an inner-phase droplet size advantageously larger than 500 nm or larger than 1,000 nm. This deficiency is cured by the teachings of Fowler.

Finding of Prima Facie Obviousness Rational and Motivation

(MPEP §2142-2143)

It would have been *prima facie* obvious for one of ordinary skill in the art at the time of the present invention to combine the respective teachings of Stroud *et al.* and Fowler to deduce applicants claimed invention.

Stroud *et al.* disclose a method for self-tanning human skin comprising topically applying to the skin an effective amount of an oil-in-water emulsion containing dihydroxyacetone, wherein the emulsion must remain on the skin for a prolonged period of time after application sufficient for the sunless-tanning Maillard reaction to result in the formation and even-distribution of the desired amount of brown pigments (Col. 1, lns. 21-28; Col. 3, lns. 33-43). Since Fowler teaches that an oil-in-water emulsion having individual emulsion droplets with a uniform diameter of about 1-10 μm (e.g. 1,000 to 10,000 nm) exhibits greater stability, and imparts a desirably elegant feel that is non-oily or non-greasy when applied to the skin (Col. 2, lns. 13-23, 39-43; Col. 3, lns. 45-56; Col. 4, lns. 56-58; Col. 5, lns. 4-12), one of ordinary skill in the art would be motivated to manufacture the oil-in-water emulsion of Stroud *et al.* with individual emulsion droplets having a uniform diameter of about 1-10 μm (e.g. 1,000 to 10,000 nm), with the reasonable expectation that the resulting emulsion will successfully exhibit greater stability and impart an elegant feel when applied and worn on the skin.

In light of the forgoing discussion, the Examiner concludes that the subject matter defined by the instant claims would have been obvious within the meaning of 35 USC 103(a).

From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Inquiries

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAVID M. BROWE whose telephone number is 571-270-1320. The examiner can normally be reached on Monday-Friday 7:30AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann R. Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DAVID M. BROWE
Patent Examiner, Art Unit 1616

/Ernst V Arnold/

Primary Examiner, Art Unit 1616